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In The  
**UNITED STATES CIRCUIT COURT OF APPEALS**

**For the Ninth Circuit — Number 9693**

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THE L. McBRINE COMPANY, LIMITED,

Appellant,

vs.

SOL SILVERMAN and SAM SILVER-  
MAN,

Appellees.

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THE L. McBRINE COMPANY, LIMITED,

Appellant,

vs.

HERMAN KOCH, HAROLD M. KOCH,  
WILLIAM L. KOCH, and REBECCA  
KOCH,

Appellees.

Consolidated

**FILED**

JUL 17 1941

**PAUL P. O'BRIEN,**  
CLERK

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**PETITION FOR REHEARING**

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Upon Appeals from the District Court of the United States  
for the Northern District of California — Southern Division.

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This Honorable Court, apparently recognizing that the very vague, indefinite, and clearly insufficient and unsatisfactory proof with respect to the alleged Koch prior use was not the type of proof necessary under well established principles of patent law to overthrow a patent, has ordered in its decision dated June 25, 1941, that that portion of the



ment in such a way that the garment may be quickly and smoothly packed in the cover without strain or stretching, with all of the cover area utilized. To obtain this result it is necessary that the swinging garment supporting frame have its hinged connection *adjacent* the hinged wall of the cover, but it is not essential that the frame be literally connected to the hinged wall of the cover, as long as the pivot pin is *adjacent* thereto so that the entire area of the cover may be utilized.

With this type of decision it is impossible to see how a patent can have any value in the Ninth Circuit because the decision opens the way to clearly evasive infringements where the infringer obtains all of the advantages of a patented idea. A rehearing to correct this unintentional but flagrant error is strenuously urged.

On a question of the type involved in this petition for rehearing it makes no difference whether the claims are read to mean that the frame is carried on the hinged wall or to mean that the frame may be carried on the walls at right angles to the hinged wall, as long as the position of the pivot for the swinging garment supporting frame remains adjacent the hinged wall. The two constructions are, therefore, obvious mechanical equivalents, and there is no justification for a court of equity to rely upon hair splitting distinctions.

We urgently beg this Honorable Court to carefully consider the Supreme Court case of *Sanitary Refrigerator Co. vs. Winters*, 280 U. S. 30, wherein it was stated in a case involving a latch:

“The only differences are that in the Dent latch the keeper has on the inner or door side of the triangular head a lug projecting inwardly toward the latch lever; and the upper arm of the latch lever is

a short inclined cam placed at the pivot of the latch lever, and so constructed and at such an angle that it rides upon and contacts with the lug on the side of the keeper head, *instead of with its upper curved side as in the Winters and Crampton structure.* \* \* \*

“Despite the changes in the Dent latch from the Winters and Crampton structure we find that the two devices are substantially identical, operating upon the same principle and accomplishing the same results in substantially the same way and that the slight change in the form of the Dent latch is merely a colorable departure from the Winters and Crampton structure. \* \* \*

“Authorities concur that the substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself so that if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same even though they differ in name, form or shape. \* \* \*

“A close copy which seeks to use the substance of the invention, and, *although presenting some change in form and position,* uses substantially the same devices, performing precisely the same offices and with no change in principle, constitutes an infringement. *Ives vs. Hamilton*, 92 U. S. 426, 430. And even where in view of the state of the art the invention must be restricted to the form shown and described by the patentee and cannot be extended to embrace a new form which is a substantial departure therefrom, it is, nevertheless, infringed by a device in which there is no substantial departure from the description in the patent but a mere colorable departure therefrom.” (Italics added)

There could be no more colorable departure from a patented structure than the mere shifting of a corner bracket support from one wall adjacent the corner to the other wall adjacent the corner. *No possible change in function or result could come from such shifting of the bracket support.*

However, all that the infringers have done is to adopt one of the modified showings of the patent in suit, as is clearly indicated by Fig. 6 therein. (R. p. 456) This figure clearly shows that the patentee had in mind the obvious alternative, used by the defendants, of connecting the bracket support to *either* wall adjacent the corner. It is felt that this Court must have overlooked this particular showing in the patent in suit, and possibly it was not called to the Court's attention because no one anticipated that the case would be decided on any such point. Fig. 6 of the Shoemaker patent illustrates the additional feature of being able to slide the pivot pins upwardly in the slots 18 of the *side wall brackets*. This does not, however, change the effect of the showing on the present petition for rehearing, because when the frame is in the position of Fig. 6 it is supported in the same manner and on the same walls as used by the infringers. In the Shoemaker specification, page 2, lines 29, et seq. (R. p. 463), it is stated with respect to the various methods of hingedly connecting the frame:

“I do not wish to be limited in the means or manner whereby the base portion 16 of the supporting member 12 is hingedly or pivotally connected in the relationship to the cover 10. In Fig. 2 I have shown hinges 17, which provide an equivalent means for hinging the base portion 16 relative to the cover 10. In Fig. 5, (of which Fig. 6 is an enlarged detail) I have shown guide plate 18 *carried on the inner faces of the opposite sides forming the cover 10*. These guide plates are provided with a longitudinal slot 19 in which the ends of the pins 20 may be moved. In this particular construction, the pins 20 are provided with grooves adjacent their free ends and the ends of the pins are positioned in locked relationship in their respective slots 19 of the guide plates 18, as shown in Fig. 6.” (Matter in parentheses and italics above inserted.)

In its decision this Court stated:

“It is instead a garment supporting member connecting to and supported by the two lateral (unhinged) side walls of the cover portion. No such garment supporting member is described or referred to in any of the claims in suit.”

The above statement, however, it is respectfully urged, is not in accordance with the principles of patent law as enunciated by the Courts because claims, on questions of this character, are always read in the light of the specification and drawings, and the above references to Fig. 6 of the patent in suit clearly show that the infringers' obvious equivalent was contemplated by the patentee as within the scope of his invention, and the use of hair splitting distinctions to relieve such an infringer is not justified by the facts. In its decision this Court also stated:

“In the specification the hinged side wall of the cover portion is called its hinged side.”

In referring to this preferred nomenclature the Court apparently overlooked other statements in the specification, such as the one,

“I do not wish to be limited in the means or manner whereby the base portion 16 of the supporting member 12 is hingedly or pivotally connected in relationship to the cover 10.” (R. p. 463, lines 29 to 33)

In addition to the above, even without the showings of Figs. 5 and 6 of the drawing, and even without the above statement in the specification, the principles of mechanical equivalency would apply to prevent an evasive attempt as apparent as that resorted to in the present case.



*File History.*

On page 29 of appellees' main brief there is a confusing discussion of the file history, which was presented in an endeavor to impress the Court that the patentee's entire novelty was based on the minor and unimportant difference of extending a corner bracket downwardly to connect with the hinged wall of the case instead of obtaining the identical result by extending the bracket support laterally (without changing the adjacency of the hinge to the hinged wall of the suitcase) as was done by the infringers in this case. (See chart in this petition.)

If this had been the only novelty, no Patent Office would have allowed the patentee's claims because such a minor change will neither support the grant of a patent nor relieve an infringer.

*Both the Examiner and Applicant's Attorney Considered the Expressions, "carried by the hinged side of said cover" and "in said cover adjacent the hinged connection" to be Equivalent Ways of Defining the Same Invention.*

The portion of the file history stressed by appellees was that in which the Examiner originally objected to the word "relative" in defining the location of the hinge. The Examiner stated, "Relative is ambiguous." As a result of trying to avoid ambiguity applicant used the expression, "carried by the hinged side of said cover" in some claims and the expression, "adjacent the hinged connection" in other claims. The latter is the definition contained in claim 15 of the patent in suit. This claim was not one of those relied upon in the present case because the claim did not bring out in addition to the hinged frame 12 the use of a removable bar such as the bar 30. Inasmuch as both of the

infringers in this case employ the combination of the frame with a removable bar for creating the novel "four-fold," only those claims defining both the swinging frame 12 and the removable bar 30 were relied upon.

Reference to claim 15, however, is pertinent in determining the scope of those claims relied upon with respect to the definition of the mounting for the hinged supporting member. Claim 15 was originally claim 42 (see page 514 of the record), and originally stated merely that the supporting member was mounted anywhere in the cover. On page 527 of the record, in acting on this claim the Examiner stated:

"To be allowable, this claim would have to recite also first that the member is mounted *adjacent* the hinged connection of the lid, and second, that the member extends approximately to the free edge of the lid." (Italics inserted)

The Examiner did not require that the claims state that the supporting member is "carried by the hinged side of the supporting member." He considered the two expressions to be equivalents. In response to this action claim 15 (original claim 42), was amended as indicated by the caret and handwriting in the last line on page 514 of the record of this case. The claim was then allowed.

There is no question, therefore, that the Examiner considered the expressions "carried by," "connected to," and "adjacent" to be equivalent expressions, and likewise to be allowable recitations of the position of the hinge for the swinging garment supporting member 12. This is directly in accord with the patentee's concept, who showed the alternative mechanically equivalent structure in Fig. 6 of his drawing.

**CONCLUSION.**

It is apparent from the above, that the decision of this Court is in direct conflict with the Examiner's idea of what the invention was, is in direct conflict with the patentee's own idea, and is in direct conflict with the well recognized law of mechanical equivalency as set forth by the Supreme Court in the case of *Sanitary Refrigerator Co. vs. Winters*, 280 U. S. 30, hereinbefore referred to.

A rehearing is respectfully urged to prevent a miscarriage of justice and to prevent this case from establishing a doctrine in the Ninth Circuit that infringement can be avoided by resorting to obvious mechanical equivalents while obtaining all of the benefits of a patentee's invention.

Respectfully submitted,

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